

Appl. No. 10/621,254
Amdt. dated February 5, 2007
Reply to Office Action of January 4, 2007

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REMARKS/ARGUMENTS

Claim 1 has been revised to include the radiation feature from claim 113 and originally filed claim 129. Claims 31-45, 47, 50-52, 55-68, and 85-87 have been revised to be dependent upon claim 1. Claim 112 has been revised to be in independent form and to include the radiation feature found in claim 113. Claim 113 has been revised to conform to the changes in claim 112.

New claims 151-157 are dependent from claim 1 and correspond to originally filed claims 131 and 135-140.

Claims 11-18, 20-30, 46, 48, 49, 53, 54, 69-84, 88-111, and 122-150 have been canceled. Applicants reserve the right to pursue the subject matter of any non-elected claim or canceled subject matter in a subsequent divisional or other continuing application without prejudice.

No new matter has been introduced, and entry of the above revised claims is respectfully requested.

Restriction Requirement

Reconsideration and modification or withdrawal of the Restriction Requirement is respectfully requested in light of the following remarks.

The Restriction Requirement alleges the following Groups:

Group I, claims 44-46, 52-53, 98, 99, 102, 103;

Group II, claims 47-49, 54, 55, 108 and 109;

Group III, claim 50;

Group IV, claim 51;

Group V, claim 56;

Group VI, claim 57;

Group VII, claim 58;

Group VIII, claim 59;

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Group IX, claims 60-62, 67, 68, 104-107;
Group X, claims 9, 10, 86, 87, 112-121;
Group XI, claims 11, 12, 88, 89;
Group XII, claims 13-15;
Group XIII, claims 16-22;
Group XIV, claims 143-145; and
Group XV, claims 146-150.

Among the above, Groups I-IX contain only composition claims while Groups X-XV contain only method claims. Because the claims have been revised to feature methods of the invention, Applicants believe that the allegations regarding restriction relative to the subject matter of Groups I-IX is no longer applicable. Additionally, claims alleged to be in Groups XI-XV have been canceled without prejudice for re-presentation in a continuing application. Therefore, Applicants will focus on the allegations regarding the remaining method claims.

The Requirement alleges that each of Groups X-XV (claims 9-22, 60-62, 67, 68, 86-89, 104-107, 112-121, and 143-150) is an invention relating to a distinct method "because each of the inventions is directed to a separate class of disease". But Applicants point out that no separate classification or evidence of distinction in the art has been provided with the Restriction Requirement. Therefore, Applicants submit that no serious burden of search is present for consideration of all the claims.

The Requirement also asserts that claims 1-8, 23, and 83-85 "link" Groups X-XV. Furthermore, The Requirement states that "[t]he restriction requirement between the linked inventions is subject to the nonallowance of the linking claims.... Upon the allowance of the linking claims, the restriction requirement as to the linked inventions shall be withdrawn and any claims depending from or otherwise requiring all the limitations of the allowable linking claims will be entitled to examination in the instant application." See page 4 of the Restriction Requirement.

Applicants understand the above to indicate that should one of Groups X-XV be elected, the respective linking claims will be examined with the elected Group and should the linking claim be found allowable, the claims of the remaining linked Groups will be rejoined and

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PATENT

fully examined for patentability. Should this understanding be incorrect, Applicants request clarification in the next Office Communication of how the linking claims will be treated.

Additionally, and as explained above, only Group X and the "linking claims" remain in the instant application. Therefore, and should Group X be examined and be found allowable, Applicants understand that the linking claims will be examined fully on the merits. Again, and should this understanding be incorrect, Applicants request clarification in the next Office Communication.

Presence of Genus Claims

Even if the above understanding is correct, Applicants respectfully traverse the assertion of the Groups as two clusters of separate inventions, where each cluster includes multiple "linked inventions." Applicants point out that the alleged separation of the claims into each of the two clusters appears to reflect a failure to recognize the presence of genus claims, which is reflected in claims 1, and previous claims 69 or 83, as representative examples. The asserted separation of claims into the Groups within each cluster is an improper separation of the genus into the species alleged as each of Groups I-IX or X-XV *without recognition of the genus claims*.

A generic, or genus, claim is defined at MPEP 806.04(d). Among the pending claims, at least claims 1-8, 19, 31-45, 47, 50-52, 55-68, 85, and 151-157 are generic, or genus, claims within that definition (and relative to the asserted species of Group X, claims 9, 10, 86, 87, and 112-121). No reason has been provided as to why claims 1-8, 19, 31-45, 47, 50-52, 55-68, 85, and 151-157 are not generic, or genus, claims within the definition set forth at MPEP 806.04(d). In fact, claims 1-23, 83-89, 112-121, and 143-150 are identified as "generic" claims on page 11 of the Requirement. Many of these claims are alleged to be "linking" claims as noted above.

Applicants respectfully submit that it is improper, as well as legally inconsistent, to simultaneously allege claims as "linking", and thus not generic, in one part of the Restriction Requirement, and as "generic" in another part of the Restriction Requirement.

Appl. No. 10/621,254
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PATENT

Recognition of the presence of genus claims is important because Applicants regard the subject matter of the genus claims as their invention. All of the pending claims include the radiation feature disclosed in the application and claims as originally filed. Any attempt to restrict the genus to be merely species thereof would deny Applicants the ability to seek claims directed to what they regard as the invention. See *In re Weber* (580 F.2d 455, 198 USPQ 328 (CCPA 1978)) and *In re Haas* (580 F.2d 461, 198 USPQ 334 (CCPA 1978)), and the discussion at MPEP 803.02. These decisions clearly set forth that a restriction requirement cannot be used to divide a single claim, such as a genus claim. Therefore, and by way of example, claims 1-8, 19, 31-45, 47, 50-52, 55-68, 85, and 151-157 cannot be divided by restriction.

The fact that restriction contrary to *Weber* and *Haas* has occurred is seen in the case of the above claims being alleged as "linking claims" such that they belong to more than one asserted Group.

In light of the above arguments, and even if the understanding of the prosecution of "linked inventions" indicated above is correct, Applicants respectfully request reconsideration and modification of the instant Restriction Requirement at least in favor of one group in place of asserted Group X and the alleged linking claims.

In the event that the Restriction Requirement is maintained, Applicant elects alleged Group X, claims 9, 10, 86, 87, and 112-121, which feature the treatment of cancer, with traverse for the reasons provided above.

Required election of species

The Restriction Requirement mailed January 4, 2007 further includes a requirement for election of a species from among 7 alleged "species of ligand" in the event one of Groups X-XV is elected.

As explained above, the requirement for an election of species includes a recognition of generic claims. Given the presence of genus claims, as presented above, Applicants point out that a requirement for an election of species from the genus of claimed

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PATENT

compositions must be based upon 37 C.F.R. § 1.141(a) and 1.146, both of which expressly recognize that “a reasonable number” of species may be claimed along with an allowable generic claim within a single application. Applicant points out that there has been no demonstration that “more than a reasonable number of species” is encompassed by the pending claims. To the contrary, Applicants respectfully submit that the presence of only 7 species is clearly “reasonable” in comparison to genus claims in issued patents that encompass enormous numbers of species. Therefore the requirement is deficient because no more than a reasonable number of species is presented in the pending claims.

Moreover, and as set forth at 37 C.F.R. § 1.146, election of a species is discretionary and results in a restriction *only* “if no claim to the genus is found to be allowable.” Thus Applicants respectfully submit that the requirement for an election of species is for purposes of facilitating search and examination. If no prior art is found to anticipate or render obvious the elected species, Applicants respectfully submit that the search of the claims should be extended to the next species to allow for consideration of the generic claim encompassing the species.

In light of the above, Applicant respectfully submit that the requirement for an election of species is misplaced and should be withdrawn.

Should the requirement be maintained despite the above, Applicants elect the species of “f) nucleic acid” as encompassed by claims 1-10; 19, 31-45, 47, 50-52, 55-68, 85-87, 112-121, and 151-157, where at least claims 1-10, 19, 31-43, 55-60, 63-68, 85-87, 112-117, 120, 121, and 151-157 are generic. This election is made with traverse for the reasons provided above.

Finally, and in the unlikely event that a fourth restriction requirement is deemed necessary in the instant application, Applicants respectfully request that the Examiner contact the undersigned for a telephonic election to avoid further delays in prosecution.

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CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 858-350-6100.

Respectfully submitted,


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